



ITW
DAC

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0875-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Alaine BETHUNE et al.) Group Art Unit: 1775
)
Application No.: 09/824,244)
) Examiner: A. Sperty
Filed: April 3, 2001)
)
For: OBJECT HAVING A DECORATIVE)
PATTERN AND METHOD OF APPLYING)
THE DECORATIVE PATTERN)

Commissioner for Patents ,
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO ENTER AMENDMENT UNDER 37 C.F.R. § 1.181

Pursuant to 37 C.F.R. §1.181, Applicants hereby respectfully petition the Commissioner to instruct the Examiner to enter an Amendment After Final ("Amendment") filed on September 2, 2004 under 37 C.F.R. § 1.116. This Petition is being timely filed within two months from the mailing date of an Advisory Action dated September 23, 2004.

In the final Office Action dated June 2, 2004, the Examiner objected to the specification and the drawings for alleged minor informalities.¹ Specifically, the Examiner objected to the disclosure for lack of section headings, and objected to the

¹ The objections to the specification and the drawings were raised for the first time in that final Office Action.

drawings for an asserted lack of clarity in designating a decorative pattern with reference character "6."

With respect to the drawing objection, the Examiner alleged that

[n]ew corrected drawings are required ... because numeral 6 of Figures 2B and 2C indicates a raised portion, while the specification dictates that the decorative pattern 6 is the removed or indented portion.

In response to the final Office Action, Applicants filed the Amendment under 37 C.F.R. § 1.116 to place this application in better form for appeal. In that Amendment, as the Examiner specifically required, Applicants proposed amending the specification to include appropriate section headings, and amending Figs. 2B and 2C to more clearly indicate that the reference character "6" designates a decorative pattern, as suggested by the Examiner. That Amendment did not propose any amendments to the claims.

Nevertheless, the Examiner issued an Advisory Action dated September 23, 2004, alleging that the proposed amendments raised the issue of new matter and refused to enter the amendments. See Advisory Action dated September 23, 2004. In that Advisory Action, the Examiner alleged that

the drawing figures have been relied upon for indication of the location of the decorative pattern. The submitted drawing changes indicate a different location for the decorative pattern, therefore changing the interpretation of the specification and introducing matter which is new with relation to the previously examined invention.

Applicants respectfully submit that the Examiner's reasoning set forth in the Advisory Action is baseless and unsupportable because, among other reasons, the proposed drawing change does not alter the identified location of the decorative pattern. Instead, the proposed drawing change merely involves adding an arrow to the end of a

lead line of reference character "6" in order to accommodate the Examiner's suggestion provided in the final Office Action. Since the proposed drawing change did not modify the location of the decorative pattern to be different from that of the original application, the drawing change proposal is consistent with the original application as filed, and does not raise any new matter.

Moreover, even hypothetically if the proposed drawing change results in even a slight change of the identified decorative pattern location, such a drawing change was required by the Examiner. As M.P.E.P. § 714.12 clearly sets forth, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). As is abundantly clear, the proposed amendments to the specification and the drawings provide compliance with the Examiner's formality objections/requirements and place this application in better form for appeal. Therefore, Applicants' proposed amendments should be entered.

For the reasons set forth above, Applicants respectfully request that the Commissioner instruct the Examiner to enter the Amendment filed under 37 C.F.R. § 1.116 on September 2, 2004, placing this application in better form for appeal.

Please grant any extensions of time required to enter this Petition and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 23, 2004

By: Anthony M. Gutowski (Reg. No. 38,742)
to: Reg. No. 38,742